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| 10/022,857 | 12/20/2001 | Minoru Suzuki | 016887-1057 | 1434 |
| 22428 | 7590 | 10/06/2005 | EXAMINER | |
| FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007 | | | POKRZYWA, JOSEPH R | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2622 | |

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/022,857

Applicant(s)

SUZUKI, MINORU

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,11-15 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 3,4,7-10 and 16 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/12/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The references listed in the Information Disclosure Statement submitted on 6/12/02 have been considered by the examiner (see attached PTO-1449).

Drawings

2. The drawings were received on 6/12/02. These drawings are acceptable by the examiner.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1, 2, 5, 6, 11-15, and 17-20** are rejected under 35 U.S.C. 102(e) as being anticipated by Tanimoto (U.S. Patent Application Publication 2002/0080414).

Regarding *claim 1*, Tanimoto discloses an image communications system for receiving fax image data encoded with specific facsimile data format and carrying transmission codes having no relation with image contents (see abstract, and paragraphs 0081-0089), converting the received fax image data into Internet-fax data in a specific format, and transferring the Internet-fax data to an Internet terminal as an in-system terminal (paragraphs 0005, and 0083-0089), the

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system comprising a receiver to receive the fax image data supplied via a regular communications network (see Fig. 9, paragraphs 0081-0082), a comparator to compare an encoding mode for the received fax image data and an encoding mode for the Internet-fax data for the Internet terminal (see Fig. 10, paragraphs 0083-0089), a converter to add format data for the Internet-fax data to the fax image data with no decoding of the fax image data if there is a match in the comparison (steps S25 and S26 in Fig. 10, paragraphs 0083-0089), for converting the format data-added fax image data into the Internet fax data (step S22 in Fig. 10, paragraphs 0083-0089), and a transmitter to transmit the converted Internet fax data to the to the Internet terminal (steps S23, S25, and S26 in Fig. 10, paragraphs 0083-0089).

Regarding *claim 2*, Tanimoto discloses the system discussed above in claim 1, and further teaches that the comparator includes a mode comparator to compare the encoding mode for the received fax image data and an encoding mode for the Internet-fax data to be used at the in-system Internet terminal (paragraphs 0083-0089), a detector to detect whether or not there is a match between the encoding mode for the received fax image data and the encoding mode for the Internet-fax data (paragraphs 0083-0089), and a data switch to output the fax image data to the converter if there is a match in a comparison result at the detector whereas to output the Internet-fax image data generated in the system to the converter if there is no match (steps S23, S25, and S26 in Fig. 10, paragraphs 0083-0089).

Regarding *claim 5*, Tanimoto discloses the system discussed above in claim 2, and further teaches that the converter includes an Internet-fax data generator to output the fax image data to the converter if there is a match at the detector of the comparator between the encoding mode for the received fax image data (step S22 in Fig. 10, paragraphs 0083-0089) and the

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encoding mode for the Internet-fax data whereas, if there is no match, add format data for the Internet-fax data to data output from the data switch, the output data carrying image contents for Internet facsimile (steps S25 and S26 in Fig. 10, paragraphs 0083-0089).

Regarding *claim 6*, Tanimoto discloses the system discussed above in claim 1, and further teaches that the comparator includes a supplier to supply a comparison result of comparing an encoded an encoding mode for fax image data supplied from a modem and an encoding mode for in-system Internet-fax data to the converter (paragraphs 0005-0021, and 0083-0089), and a switch to switch G3-compatible code data supplied from the modem and internet-fax image data encoded for an in-system terminal, having an input terminal for receiving the Internet-fax image data (paragraphs 0005-0021, 0055-0056, and 0083-0089), and a movable contact for switching the data at the two input terminals based on a result of the mode comparison, and the converter includes a TIFF converter (paragraphs 0010-0016, 0050-0056, and 0083-0089), in response to either the fax image data or the Internet-fax image data switched by the switch, to add TIFF data that is format data for the Internet-fax data to either the fax image data or the Internet-fax image data, thus generating the Internet-fax data (paragraphs 0005-0021, 0050-0056, and 0083-0089).

Regarding *claim 11*, Tanimoto discloses the system discussed above in claim 1, and further teaches that the fax image data has been encoded by a G3-mode compatible encoding technique (paragraphs 0005-0021, 0055-0056, and 0083-0089).

Regarding *claim 12*, Tanimoto discloses the system discussed above in claim 11, and further teaches that the specific code having no relation with image contents are fill bits that have

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been added to the encoded data per line, depending on necessity (paragraphs 0005-0021, 0055-0056, and 0083-0089).

Regarding *claim 13*, Tanimoto discloses the system discussed above in claim 11, and further teaches that the G3-mode compatible encoding technique is modified Huffman (MH) encoding, modified READ (MR) encoding, modified-modified READ (MMR) encoding or joint bi-level image experts group (JBIG) encoding (paragraphs 0014, and 0049-0056).

Regarding *claim 14*, Tanimoto discloses the system discussed above in claim 11, and further teaches that the format data for the Internet-fax data includes data in a tag image file format (TIFF) that defines an attribute of the image data with information including a tag (paragraphs 0005-0021, 0055-0056, and 0083-0089).

Regarding *claim 15*, Tanimoto discloses an image communications system for receiving fax image data encoded with specific facsimile data format and carrying transmission codes having no relation with image contents (see abstract, and paragraphs 0081-0089), converting the received fax image data into Internet-fax data in a specific format, and transferring the Internet-fax data to an Internet terminal as an in-system terminal (paragraphs 0005, and 0083-0089), the system comprising a receiver to receive the fax image data supplied via a regular communications network (see Fig. 9, paragraphs 0081-0082), a comparator to compare an encoding mode for the received fax image data and an encoding mode for the Internet-fax data for the Internet terminal (see Fig. 10, paragraphs 0083-0089), a code detector, based on the encoded data for which the encoding mode has been compared, to detect a specific code from a specific encode data, the specific code having no relation with image contents, and delete the detected specific code with no decoding of another code (paragraphs 0050, 0060-0066, and

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0115), a converter to add format data for the Internet-fax data to the fax image data with no decoding of the fax image data if there is a match in the comparison (steps S25 and S26 in Fig. 10, paragraphs 0083-0089), for converting the format data-added fax image data into the Internet fax data (step S22 in Fig. 10, paragraphs 0083-0089), and a transmitter to transmit the converted Internet fax data to the to the Internet terminal (steps S23, S25, and S26 in Fig. 10, paragraphs 0083-0089).

Regarding *claim 17*, Tanimoto discloses the system discussed above in claim 15, and further teaches that the fax image data has been encoded by a G3-mode compatible encoding technique (paragraphs 0005-0021, 0055-0056, and 0083-0089).

Regarding *claim 18*, Tanimoto discloses the system discussed above in claim 17, and further teaches that the G3-mode compatible encoding technique is modified Huffman (MH) encoding, modified READ (MR) encoding, modified-modified READ (MMR) encoding or joint bi-level image experts group (JBIG) encoding (paragraphs 0014, and 0049-0056).

Regarding *claim 19*, Tanimoto discloses the system discussed above in claim 17, and further teaches that the fax image data encoded by the G3-mode compatible encoding technique includes at least one EOL code, data related to the image contents and fill-bit data (paragraphs 0005-0021, 0055-0056, and 0083-0089).

Regarding *claim 20*, Tanimoto discloses the system discussed above in claim 17, and further teaches that the format data for the Internet-fax data includes data in a tag image file format (TIFF) that defines an attribute of the image data with information including a tag (paragraphs 0005-0021, 0055-0056, and 0083-0089).

Allowable Subject Matter

5. **Claims 3, 4, 7-10, and 16** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Citation of Pertinent Prior Art

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Tonegawa (U.S. Patent Application Publication 2001/0033390) discloses an Internet facsimile system; and

Kitagawa (U.S. Patent Number 6,157,463) discloses a facsimile system.

Conclusion

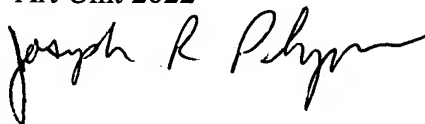
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (571) 272-7410. The examiner can normally be reached on Monday-Friday, 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joseph R. Pokrzywa
Primary Examiner
Art Unit 2622



jrj